

REMARKS**CLAIM OBJECTIONS**

The Office objected to Claim 1 regarding a typographical error. That error is fixed in the current amendments.

The Office objected to Claims 3-5 regarding an additional typographical error, omission of the term "tool". That error is fixed in the current amendments, and claim 2 is also amended to provide consistency.

35 USC §112 (FIRST PARA)

Claims 1-5 were all rejected under 35 U.S.C. § 112 as failing to comply with the written description requirement relative to the term "that is biased towards the safety position." The applicant disagrees. The safety position is clearly shown in Figures 1 and 4 by the guard 16 covering the edge and portion of the side of the blade 20, while the operating position is shown in Figures 5 and 6. Now it may be that the applicant never used the term "safety position" in the specification. But that is irrelevant. There is no requirement that every term used in a claim is found verbatim in the specification.¹ All that is required is that the claimed invention be apparent from the specification. That requirement is unquestionably satisfied with respect to the term "safety position."

Moreover, "biasing" of the blade cover towards the safety position is clearly shown in the figures, and taught in the specification. See para [0022] "When this occurs, the return spring 56 immediately draws the blade cover 16 distally to cover the cutting edge 18 of the blade 20."

¹ See, e.g., *Bilstad v. Wakalopoulos*, 386 F.3d 1116, 1123 (Fed. Cir., 2004) [approving of *In re Smyth*, 480 F.2d 1376, 1382 (CCPA 1973) decision finding sufficient written description for "inert fluid," though the term "fluid" did not appear in the written description]; and *Storage Tech. Corp. v. Cisco Sys*, 329 F.3d 823, 834-835 (Fed. Cir., 2003) [term in preamble considered limiting element, even though term never used in specification].

35 USC §112 (SECOND PARA)

Claims 1-5 were all rejected under 35 U.S.C. § 112 as being indefinite with respect to "re-engages" the locking assembly. The applicant disagrees on this point, but in the interest of pushing the application forward have made the following clarification: "a manually triggered self-locking release assembly, internal to the handle, that operates to unlock ~~unlocks~~ the cover when a trigger is operated, so that the cover can be retracted, and operates to re-lock ~~re-engages~~ the locking assembly upon manual retraction of the cover." The term "operates" is broad enough to cover the disclosure in the specification.

The Office also asks whether "the locking assembly" refers to the "manually triggered self-locking release assembly". The answer is yes, as it must be to preserve antecedent basis. There is only one locking assembly" referred to in the claim, so that a reference to "the locking assembly" must perforce refer to the previously recited "manually triggered self-locking release assembly". Referring over and over to the "manually triggered self-locking release assembly" is mere prolix.

35 USC §103

Claims 1- 5 were rejected under 35 USC §102 as being obvious over Stevenson (US 4091537) in view of Owens et al. (US 5878501). The Office admits that Stevenson fails to teach the cover covering both the cutting edge of the blade and at least a portion of the side of the blade. The Office maintains, however, that the missing element is satisfied by combination of Stevenson with Owens.

The applicant disagrees with the rejection because the Office has failed to make a prima facie case of obviousness. One cannot simply assert that the claimed subject matter is obvious over the references. The Office must provide hard evidence *within the prior art* that teaches, suggests or motivates the combination, and the choosing of specific elements from each of the references. That was not done here, and indeed cannot be done because the references don't provide the needed support.

Moreover, the text of Stevenson clarifies that Stevenson contemplates a particular shape of blade guard, namely "it has to be particularly pointed out that the shape of the retractable blade guard 26 is that of an elongated rod." (Spec., col. 4, lines 25-27). That is hardly language that would encourage one of ordinary skill in the art to choose a blade guard of different shape, or to substitute the *blade cover* of Owens et al. for the *blade guard* of Stevenson.

Still further, the Stevenson patent issued in 1978, and therefore was known at the time (Aug 1997) that Owens et al. was filed. Yet Owens et al. chose not to include the special locking, unlocking mechanism in his teachings, *deciding instead to address the issue of an unprotected blade with a sliding member 76 that is rigidly coupled to the blade*. Such a sliding member is inherently inconsistent with the trigger type operation contemplated by Stevenson, and claimed in the instant claims. Since the two strategies for dealing with the same problem are mutually inconsistent, one of ordinary skill in the art would not have thought to combine the teachings of those two references.

Nevertheless, in the spirit of cooperation, the applicant is willing to amend the claims further to clarify that the claimed trigger is index finger operated. That distinction should further distinguish Owens et al. as a reference. Thus, claim 1 (and claims 2-5 by virtue of their dependency on claim 1) are amended herein to recite that the trigger is finger-operated (as opposed to being thumb operated).

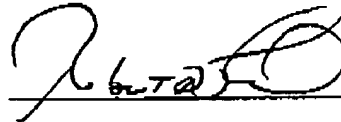
REQUEST FOR ALLOWANCE

Claims 1-5 are pending in this application. The applicants request allowance of all pending claims. Since this is a response on a final rejection, and since all amendments herein are further limitations as opposed to broadening the claimed subject matter, the applicant requests that the amendments be entered even if the Office continues to reject the claims. That will place the claims in position for immediate appeal.

In addition, if there are minor points that can be resolved by conference call, the applicant request that they be resolved over the phone.

Respectfully submitted,

Rutan & Tucker,

A handwritten signature in dark ink, appearing to read 'R. Fish', is written over a horizontal line.

Robert D. Fish, Esq.
Reg. No. 33880

Dated: September 14, 2004

Attorneys for Applicant(s)
Rutan & Tucker LLP
611 Anton Boulevard, Fourteenth Floor
Costa Mesa, CA 92626-1998
Tel: (714) 641-5100
Fax: (714) 546-9035